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Nicholas Luke Bennett

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Stephen M. De Klerk  
Blakely, Sokoloff, Taylor, & Zafman LLP  
Seventh Floor  
12400 Wilshire Boulevard  
Los Angeles, CA 90025

EXAMINER

NGUYEN, KIM T

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

07/03/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/856,869

Applicant(s)

NICHOLAS LUKE BENNETT

Examiner

Kim T. Nguyen

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 18-19, 23-51, 55-62, 79, 83-84, 89-90, 92-96, 100-102, 106-108, 111-122, 125, 129, 139, 140-149, 154-156, 161-165, 168-198 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/31/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Disposition of Claims: Claims pending in the application are 1-12,18,19,23-51,55-62,79,83,84,89,90,92-96,100-102,106-108,111-122,125,129,139-149,154-156,161-165 and 168-198.

### **DETAILED ACTION**

Applicant's response to restriction requirement on 4/5/07 is acknowledged.

Applicant elects species 1, claims 1-12, 18-19, 23-51, 55-62, 79, 83-84, 89-90, 92-96, 100-102, 106-108, 111-122, 125, 129, 139, 140-149, 154-156, 161-165, 168-198, without traverse. Currently, claims 13-17, 20-22, 52-54, 63-78, 80-82, 85-88, 91, 97-99, 103-105, 109-110, 123-124, 126-128, 130-138, 150-153, 157-160, and 166-167 have been cancelled, and claims 1-12, 18-19, 23-51, 55-62, 79, 83-84, 89-90, 92-96, 100-102, 106-108, 111-122, 125, 129, 139, 140-149, 154-156, 161-165, 168-198 are examined in this office action and are pending in the application.

### **Specification**

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification does not disclose control firing speed, control firing direction and control the trajectory of a ball after it is fired as claimed in claim 2, 3, 4, respectively. Further, the specification does not disclose "each credit bet in any one game by a player buys one ball" as claimed in claim 6. The specification in page 5, line 3, discloses one credit buys ten balls.

### **Claim Objections**

2. Claims 154-156 are objected to under 37 CFR 1.75(c) as being in improper because claims 154-156 depend on the canceled claim 153. The pendency of the

claims is improper. Accordingly, the claims 154-156 have not been further treated on the merits.

3. Claims 1, 5-8, 42 and 46 are objected to because of the following informalities:

In claim 1, line 7, the claimed limitation "the player to initiate the motion" should be corrected to "a player to initiate a motion".

In claim 5, lines 1-2, the claimed limitation "the number of balls provided to a player for a game" should be corrected to "a number of balls provided to the player for the game".

In claim 6, line 2, the claimed limitation "a player" should be corrected to "the player".

In claim 7, line 2, the claimed limitation "the number of balls" should be corrected to "a number of balls".

In claim 8, line 2, the claimed limitation "a player" should be corrected to "the player".

In claim 42, at the end of line 3, the punctuation "," should be corrected to ".".

In claim 46, line 2, the claimed limitation "the screen" should be corrected to "a screen".

Appropriate correction is required.

**Claim Rejections - 35 USC § 112**

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 118-122, 144-148, 161, 164-165, 171-190, 195-196 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 118 recites the limitation "the target" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 164 recites the limitation "the tools or controls" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 171 recites the limitation "the base game" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 195 recites the limitation "the base game determines the prize" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 196 recites the limitation "the base game structure" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 119-122, 144-148, 161, 165, 172-190 inherit the deficiency of claims 118, 164, 171.

### **Double Patenting**

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046,

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29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-12, 18-19, 23-51, 55-62, 79, 83-84, 89-90, 92-96, 100-102, 106-108, 111-122, 125, 129, 139, 140-149, 154-156, 161-165, 168-198 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-60 of copending Application No. 09/092,901. Although the conflicting claims are not identical, they are not patentably distinct from each other because at least independent claims 1 discloses the same subject matter taught in claims 1 and 15 of copending Application No. 09/092,901 in broader scope by eliminating the limitation displaying a game image of a hybrid game comprising one or more rotatable reels of a spinning reel game, the spinning reel and pin and ball games each potentially contributing to a single game outcome.

8. Claims 1-12, 18-19, 23-51, 55-62, 79, 83-84, 89-90, 92-96, 100-102, 106-108, 111-122, 125, 129, 139, 140-149, 154-156, 161-165, 168-198 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-162 of copending Application No. 10/110,289. Although the conflicting claims are not identical, they are not patentably distinct from each

other because at least independent claims 1 discloses the same subject matter taught in claims 1 and 150 of copending Application No. 10/110,289 in broader scope by eliminating the limitation a variable value bonus prize is awarded when a predetermined triggering event occurs, the value of the bonus prize for a future instance of the bonus prize award being altered in response to the occurrence of a predetermined prize altering event in respect of a current instance of the game.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Claim Rejections - 35 USC § 102**

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**10. Claim 1-5, 18-19, 118-122, 147, 149, 168, 171-173, 176-187 and 190 are rejected under 35 U.S.C. 102(b) as being anticipated by Ugawa (U.S. 5,836,819).**

Claim 1. Ugawa discloses an electronic gaming console having credit means, reward means, game control means, display means, and player input controls, the control means being responsive to the credit means and the player input controls to play a game which is displayed on the display means and if a winning event occurs, a player reward is awarded by the reward means, the gaming console being characterized in that the game provides a video display of a labyrinth of pins and the



player input controls allow the player to initiate the motion of ball images on the display, player rewards being awarded when the ball images come to rest in predetermined prize winning locations (Figs. 1-3; col. 33:62-34:12).

Claims 2-4. Ugawa discloses controlling firing speed, firing direction and trajectory of the ball (Fig. 2; col. 4:25-5:34 and col. 37:12-23).

Claim 5. Ugawa discloses wherein the number of balls provided to a player for a game is dependent upon a number of credits bet on the game (col. 16:60-17:10).

Claims 18-19. Ugawa discloses the number dropped is variable from game to game and is selectable by the player (col. 13:9-35 and col. 16:51-17:34).

Claims 118-122, 147. Ugawa discloses providing a plurality of targets and awarding assigned to the targets such that if a ball comes to rest in or pass through predetermined prize winning target positions and the prize winning locations are cups (Figs. 1-3).

Claim 149. Ugawa discloses providing a plurality of ball types (Fig. 41).

Claim 168. Ugawa discloses the path of the ball is affected by an object which moves the ball sideways or upward (Fig. 2).

Claim 171. Ugawa discloses incorporating a further type of game into the base game (Figs. 1-3).

Claim 172. Ugawa discloses the further game is provided as a feature game associated with the base game (the slot game and pachinko games constitute "feature" game).

Claim 173. Ugawa discloses the feature game is a spinning reel game (Figs. 2, 38a-c).

Claim 176. Ugawa discloses the feature game is a card game (i.e. the spinning reels display playing card indicia).

Claim 177. Ugawa discloses the feature game is a second screen animation (i.e. the slot game is an animation in a second screen from the pachinko game).

Claims 178. Ugawa discloses the feature game is a wheel game (Fig. 1). Slot reels are wheel games.

Claim 179. Ugawa discloses the game feature is awarded from the base game in response to a predetermined trigger (Fig. 55A). the slot game and pachinko games are awarded to the player in response to the trigger of inserting coins into the device (col. 17:17-34).

Claim 180. Ugawa discloses the feature game triggers another base game feature (Fig. 2). The pachinko game triggers the card game feature (Figs. 28A, 28B).

Claims 181-183. Ugawa discloses the feature game is played in conjunction with the base game (Fig. 2).

Claim 184. Ugawa discloses the feature game is an independent game and where a predetermined trigger condition or award causes the feature game to run, and if a winning condition is achieved in the feature game, the feature game reveals a bonus condition (Figs. 1-2, 28A, 28B, 55B; col. 33:62-34:12).

Claim 185. Ugawa discloses the bonus condition is an award of a prize (Figs. 28A, 28B).

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Claim 186. Ugawa discloses the bonus condition is a win multiplier (Fig 55B (S58, S63)).

Claim 187. Ugawa discloses the bonus condition id a number of free game.

Claim 190. Ugawa discloses the trigger condition to run the feature game is achieved by the collection of balls in a predetermined container (col. 11:35-64).

**Claim Rejections - 35 USC § 103**

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**12. Claims 6-12, 23-51, 55-62, 79, 83-84, 89-90, 92-96, 100-102, 106-108, 111-117, 125, 129, 139-146, 148, 161-165, 169-170, 174-175, 188-189 and 191-198 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ugawa (U.S. 5,836,819).**

Claims 6-8. Ugawa does not explicitly disclose each credit bet in any one game buys one ball and the previous credit bet buys less balls than the subsequence credits bet. However, setting a particular relation between a credit bet and the number of balls would have been well known and obvious matter of design choice according to a game designer's preference.

Claims 9-12. Ugawa discloses providing balls of different colors (Fig. 41; col. 27:41-51). Further, assigning prize values to the balls according to the colors of the balls and changing color of the ball as it dropped would have obvious matter of design choice according to a game designer's preference.

Claims 23-28. Ugawa discloses the number of balls to be purchased is varied (col. 16:60-17:10) and the unpurchased balls are distinguished from the purchased balls by appearance (col. 13:9-17). Further, displaying different objects in different colors, transparent, etc. to distinguish the objects from each other would have been well-known and obvious matter of design choice.

Claims 29-46. Ugawa discloses associating functions or characteristics with the balls and selecting type of the ball to be played in the game (col. 27:41-51 and col. 28:31-36). Further, plotting paths of the balls when it dropped, setting criteria to obtain bonus prize would have been obvious design choice and requires only routine skill in the art.

Claim 47. Ugawa mentioned the known feature that some wins are paid in balls rather than credits (col. 2:49-59).

Claims 48-51, 55-62, 79, 83-84, 89-90, 92-96, 100-102, 106-108, 111-117, 122, 125, 129, 139-146, 148, 161-165, 169-170, 174, 175, 188-189, 191-198. awarding particular prizes when a trigger event occurs or a winning condition is met, using different sizes of the balls to be played in a pin ball game, setting particular characteristics of the balls and pins when the balls strike the pins, playing a keno

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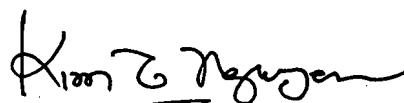
game, bingo game in the gaming machine, player selects a game, etc. would have would have been obvious design choice according to the desires of the game designer.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim T. Nguyen whose telephone number is (571) 272-4441. The examiner can normally be reached on Monday-Thursday from 8:30AM to 5:00PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai, can be reached on (571) 272-7147. The central official fax number is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Date: Jun 23, 2007

  
Kim T. Nguyen  
Primary Examiner  
Art Unit 3714